



## ATTACHMENT A Remarks

### Pending Claims Not Addressed in Rejection

It is respectfully noted that claims 49 and 50 are pending in the application, but do not appear to have been addressed in the Office Action, although box 6 of the Office Action Summary is checked, and notes that "claims 1-3, 5-35 and 37-50 are rejected." It is respectfully submitted that this omission amounts to a failure to articulate a *prima facie* case of unpatentability, and the burden to rebut the "rejection" has not yet shifted to the Applicant. Consequently, a next Office Action rejecting claims 49 and 50 cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such an Office Action sets forth a *prima facie* case. MPEP 706.07(a).

### Claim Rejections – 35 U.S.C. 103

Claims 1 – 3, 5 – 19, 21 – 35 and 37 – 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (U.S. Patent Application Publication No. 2003/0033601) ("Sakata") in view of Cheng et al. (U.S. Patent No. 6,763,403) ("Cheng"). This rejection is respectfully traversed, although claims 1, 16, 17, 32, 33 and 48 have been amended to clarify the distinctions between the claimed subject matter and the references.

#### 1) Claim 1:

Amended claim 1 recites, *inter alia*, "determining an expiration date beyond which a user may no longer use said fee-based software residing on the computer system," and "offering the user alternative software to the fee-based software based on the expiration date of the fee-based software." These distinctions are considered below.

**a) Determining an expiration date beyond which a user may no longer use the fee-based software**

The Office Action alleges that Sakata discloses a method for offering alternative software, comprising: determining an expiration date for software residing on the computer system (e.g. Fig. 2, device 67 “expiration date checking device” and related text); and offering the user alternative software to the fee-based software based on the expiration date of the fee-based software (paragraph [0013] “... software is offered to the user by rental or lease agreement ...” and paragraph [0014] “... software is replaced with new software ...”).

In response to an argument that “checking expiration dates of functions of a broadcast reception terminal” cannot be equated to “determining an expiration date of fee-based software residing on a computer system,” it is stated in the Response to Arguments section of the current Office Action that “the software expires or becomes disabled when the function of the software expires.” In support of this position, paragraph [0012] is cited for the statement that “even if the hardware is in good condition, the user cannot be provided with a new service since the software is outdated (expired).”

The Sakata reference, with respect to Fig. 2, discloses that expiration dates are set for functions (e.g., activating a remote controller, switching channels, setting a size of a display screen, turning on/off a power supply) of a broadcast reception terminal 60 (paragraph [0073]). Paragraph [0012] is unrelated to Fig. 2 and the description thereof, and describes a problem with providing a new service to a user of an information-based consumer electronic device.

With respect to the statement in the Office Action that “the software expires or becomes disabled when the function of the software expires,” the “expiration date checking device” of Fig. 2 of Sakata relates to individual functions of the broadcast reception terminal that are individually controlled by a function activation device. To the extent that the function activation device is implemented with software, it is respectfully submitted that such function of the software would necessarily continue even after any

of the individual functions of the broadcast reception terminal expire. The continued function of the software is required so that the function activation device can later re-enable those individual functions of the broadcast reception terminal (paragraph [0074]). Thus, as asserted in responses to previous Office Actions, in the context of Fig. 2 and the related text of Sakata, it is the functions of the broadcast reception terminal that expire, and not the software that implements them.

Furthermore, with respect to paragraph [0012], it is clear that the “outdated” software still functions (i.e., is not expired), but merely prevents the user from being provided with a “new service.” Thus, it is respectfully submitted that paragraph [0012] also does not contain a teaching or suggestion with respect to determining an expiration date beyond which a user may no longer use fee-based software residing on a computer system.

**b) Offering the user alternative software to the fee-based software based on the expiration date of the fee-based software**

In response to an argument that “offering a set top box having software is not the same as offering alternative software,” it is stated in the Response to Arguments section of the current Office Action that the argument is not persuasive because Sakata teaches that: 1) “a set top box (STB) or the like with a short lifetime of software is offered to the user by a rental or lease agreement (paragraph [0013]); and 2) “... necessary software (alternative software) is transferred from a server to terminal to offer a better service to the terminal ... (paragraph [0181]).” It is indicated in the Office Action that the word “alternative” is “broadly interpreted as ‘choice, another version, more possibilities, etc.’.”

With respect to the first point, paragraph [0013] only discloses offering a set top box having software to a user. It is respectfully submitted that, even reading the word “alternative” broadly, that paragraph [0013] does not contain a teaching or suggestion that the set top box having software is offered an “alternative” to anything, much less alternative software to the fee-based software as recited in amended claim 1.

With respect to the second point, it is respectfully submitted that “transferring necessary software from a server to a terminal to offer a better service to the terminal”

is also not the same thing as “offering alternative software to fee-based software based on the expiration date of the fee-based software” because, *inter alia*, the act of “transferring necessary software” is not the same as the act of “offering alternative software.” There is no element of an “offer” in the act of “transferring,” and the “transferring” is not performed based on an “expiration date” beyond which a user may no longer use the fee-based software.

Further, in response to arguments that “replacing” is not the same as the act of “offering an alternative” and that “outdated software” is not the same as “expired software,” it is stated in the Response to Arguments section of the Office Action that: 1) “It is clear that by offering the software to a user, the reason is to replace the existing software;” and 2) “Applicant’s arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.”

With respect to the first point, it is respectfully submitted that claim 1 does not recite a “reason” with respect to the step of offering a user alternative software, and that even if the reason is as alleged, that Sakata does not contain a teaching of “offering a user alternative software to the fee-based software based on the expiration date of the fee-based software,” as recited because neither “replacing outdated software” or “transferring necessary software,” contain an element of an “offer.” Sakata is concerned with updating existing software, and is not directed at a “method of offering alternative software” as recited in amended claim 1.

With respect to the second point, extensive discussion was presented in the response to the previous Office Action for the arguments in question. It is respectfully submitted that the arguments that the claim terms are different and distinguishable from the teaching of the reference comply with the requirement of pointing out how the language of the claims distinguishes them from the references. As discussed above, Sakata discloses that the functions of the set top box expire, and not the software. Sakata observes that “information-based consumer electronic devices tend to have software with a shorter lifetime than that of the hardware,” and “[t]herefore, after a

passage of time, even if the hardware is in good condition, the user cannot be provided with a new service since the software is outdated.” (paragraph [0012]) In this regard, it is clear that the “outdated” software still functions but merely prevents the user from being provided with “a new service.” This is in contrast to “expired” software which, as recited in the claim, may no longer be used. Thus, in the context of the teachings of the Sakata reference, “replacing outdated software” and “transferring necessary software to offer better service” are clearly different than “offering alternative software to fee-based software based on an expiration date of fee-based software,” as recited in claim 1.

**2) Claims 2, 3, 5 – 15, 49 and 50:**

Claims 2, 3, 5 – 15, 49 and 50 depend from independent claim 1 and are allowable for at least the reasons provided in support of the allowability of the independent claim 1. Additionally, many of the dependent claims are separately patentable as discussed below.

With respect to the separate patentability of dependent claim 2, claim 2 recites “transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, wherein the software was not authored by the software vendor and is detected by a monitoring program.

It is suggested in the Office Action that the Sakata reference discloses transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, in paragraph [0169].

Paragraph [0169] describes a means for obtaining the current date and transmitting this date to a security module. It is respectfully that the Sakata reference does not teach or suggest transmitting a message to a software vendor at predetermined time intervals prior to an expiration date, as recited in claim 2. Thus, claim 2, as well as claims 18 and 34 which contain equivalent limitations, are separately patentable over the combination of the Sakata and Cheng references.

Turning now to dependent claim 5, which recites after the offering step, providing the alternative software to the user in response to receiving an affirmative response from the user, it is suggested in the Office Action that paragraph [0099] of the Sakata reference discloses the method of claim 5. However, paragraph [0099] of the Sakata reference discloses a log transmitting device that transmits data of a program which has been viewed and recorded data, such as a response to a questionnaire which the user has filled out, to the expiration date renewal server.

It is respectfully submitted that “transmitting a response to a questionnaire which a user has filled out to a server” cannot be equated to “providing alternative software to a user in response to receiving an affirmative response from a user,” as recited in claim 5.

### **3) Claim 16:**

Independent claim 16 recites “wherein the fee-based software is provided by a first software vendor, and wherein the offer of software is made by a second software vendor different from the first software vendor.”

It is admitted in the Office Action that Sakata is “silent about the offer of software is made by a second software vendor different from the first software vendor.” It is then stated in the Office Action that “it would have been obvious ... to take the suggestions of Sakata ... to include providing a fee-based software by a second software vendor different from the first software vendor in order to sell or market another version of the pre-installed software by a second software vendor.” However, no citation is made to a prior art reference that contains a teaching of the admittedly missing element.

As noted in the Office Action, *KSR Int'l v. Teleflex Inc.* states that “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). Thus, it must be established that the elements being combined exist in the prior art. It is respectfully submitted that the admittedly missing element from Sakata has not been established to exist in the prior art, by citation or otherwise, and

that the conclusory statement that it would have been obvious to include such an element is insufficient to establish a *prima facie* case of unpatentability of the claim.

Further, claim 16 has been amended to clarify that the expiration date is a date beyond which a user may no longer use the software / fee-based software. Thus, claim 16 is allowable for at least the reasons provided with respect to the allowability of claim 1.

**4) Claims 17, 32 and 48:**

Claims 17, 32 and 48 have been rejected as being system and computer-readable medium versions of claim 16, respectively.

For at least the reasons set forth above with respect to claim 16, it is respectfully submitted that a *prima facie* case of unpatentability of the claim has not been established for claims 17, 32 and 48.

Further, claims 17, 32 and 48 have been amended to make it clear that, as in claim 1, that the expiration date is a date beyond which a user may no longer use the software / fee-based software. Thus, claims 17, 32 and 48 are allowable for at least the reasons provided with respect to the allowability of claim 1.

**5) Claims 18, 19 and 21 – 31:**

Claims 18, 19 and 21 – 31 have been rejected as being the system version of method claims 2, 3 and 5 – 15, respectively, and for the same reasons provided with respect to claims 2, 3 and 5 – 15.

However, claims 18, 19 and 21 – 31 depend from independent claim 17, which differs from the scope of claim 1. Thus, 18, 19 and 21 – 31 are not just the “system version” of method claims 2, 3, and 5 – 15. Therefore, for at least the reasons set forth above with respect to claim 17, it is respectfully submitted that a *prima facie* case of unpatentability of the claim has not been established for claims 18, 19 and 21 – 31.

Further, it is respectfully submitted that claims 18, 19 and 21 – 31 are allowable for at least the reasons provided in support of the allowability of claim 17.

#### **6) Claims 33 – 35 and 37 – 47**

Independent claim 33 has been rejected as being the computer-readable medium version of method claim 1.

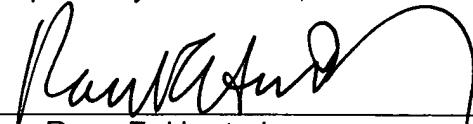
Claim 33 differs in scope from claim 1, and it is respectfully submitted that a *prima facie* case of unpatentability of the claim has not been established.

Claim 33 has been further amended such that the expiration date corresponds to the expiration date of claim 1. Thus, claim 33 is allowable for at least the reasons provided with respect to the allowability of claim 1.

Claims 34, 35 and 37 – 47 have been rejected as being computer-readable medium versions of claims 2, 3 and 5 – 15, respectively. However, claims 34, 35 and 37 – 47 depend from independent claim 33. Thus, it is respectfully submitted that a *prima facie* case of unpatentability of the claim has not been established for claims 34, 35 and 37 – 47. Further, it is respectfully submitted that claims 34, 35 and 37 – 47 are allowable for at least the reasons provided in support of the allowability of claim 33.

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